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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,781	05/04/2001	Michael Snyder	6523-028	9891

7590 04/03/2002

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New York, NY 10036-2711

EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 04/03/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/849,781

Applicant(s)

SNYDER ET AL.

Examiner

My-Chau T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-105 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16 and 93-101, drawn to a positionally addressable array and a kit, classified in class 422, subclass 61.
  - II. Claims 17-21 and 102-105, drawn to an addressable array with proteins, classified in class 435, subclass 287.1.
  - III. Claims 22-24, drawn to a positional array with a ceramic solid support, classified in class 435, subclass 287.2.
  - IV. Claim 25, drawn to an addressable array with a linker, classified in class 422, subclass 50.
  - V. Claims 26-48, drawn to an array with wells, classified in class 435, subclass 288.4.
  - VI. Claims 49 and 51-62, drawn to a method of making a positionally addressable array, classified in class 264, subclass 603.
  - VII. Claims 50 and 51-62, drawn to a method of making an addressable array, classified in class 264, subclass 636.
  - VIII. Claim 78, drawn to a method of making a positionally array with whole cells, classified in class 436, subclass 518.
  - IX. Claim 79, drawn to a method of making an array with proteins, classified in class 436, subclass 519.

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- X. Claims 65 and 69-73, drawn to a method of using a positionally addressable array with different substances, classified in class 436, subclass 2.
- XI. Claims 66 and 69-73, drawn to a method of using a positional array with proteins, classified in class 436, subclass 86.
- XII. Claims 67 and 69-73, drawn to a method of using an addressable array with polyimides solid support, classified in class 436, subclass 72.
- XIII. Claims 68-73, drawn to a method of using a positionally addressable array with a linker, classified in class 436, subclass 532.
- XIV. Claims 74-75, drawn to a method of using an array that include a depositing step with whole cells, classified in class 435, subclass 4.
- XV. Claims 76-77, drawn to a method of using a positionally addressable array with proteins, classified in class 435, subclass 3.
- XVI. Claims 80-87, drawn to a method of identifying an antigen, classified in class 435, subclass 7.24.
- XVII. Claims 88-91, drawn to method of determining the specificity of an antibody, classified in class 435, subclass 7.2.
- XVIII. Claim 92, drawn to a method of identifying a mitogen, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions of Groups I-V are unrelated and independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have

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different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as claimed have different functions and modes of operations.

The feature of a 100 different substances per  $\text{cm}^2$  of Group I is not required by the claims of Groups II-V. The feature of expressed proteins of Group II is not required by the claims of Group I and Groups III-V. The feature of a polymethylmethacrylates as a solid support of Group III is not required by the claims of Groups I-II and Groups IV-V. The feature of a 3-glycidooxypropyltrimethoxysilane linker of Group IV is not required by the claims of Groups I-III and Group V. The feature of the density of wells of Group V is not required by the claims of Groups I-IV.

3. Inventions of Group I-V and of Group VI-IX are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as photolithographic techniques or micro-machining techniques.

4. Inventions of Group I-V and of Group X-XV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that

product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as an ELISA method or Western Blot method.

5. Inventions of Group I-V and of Group XVI-XVIII are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as DNA synthesis.

6. Inventions of Groups VI-XVIII are unrelated and independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as claimed have different functions, modes of operations and method steps.

The method step of casting an array from a microfabricated mold of Group VI is not required by the claims of Groups VII-XVIII. The method step of casting an array from a secondary mold of Group VII is not required by the claims of Group VI and Groups VIII-XVIII. The method steps of depositing in wells and casting an array from a microfabricated mold of Group VIII is not required by the claims of Groups VI-VII and Groups IX-XVIII. The method steps of depositing in wells and casting an array from a secondary mold of Group IX is not required by the claims of Groups VI-VIII and Groups X-XVIII. The method step of contacting a

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probe with 100 different substances per  $\text{cm}^2$  of Group X is not required by the claims of Groups VI-IX and Groups XI-XVIII. The feature of expressed proteins of Group XI is not required by the claims of Groups VI-X and Groups XII-XVIII. The feature of a solid support of castable oxides of Group XII is not required by the claims of Groups VI-XI and Groups XIII-XVIII. The feature of attachment to a support by way of a 3-glycidooxypropyltrimethoxysilane linker of Group XIII is not required by the claims of Groups VI-XII and Groups XIV-XVIII. The method steps of depositing 100 different substances and detecting protein/probe interaction of Group XIV is not required by the claims of Groups VI-XIII and Groups XV-XVIII. The method steps of depositing proteins and contacting a probe of Group XV is not required by the claims of Groups VI-XIV and Groups XVI-XVIII. The method step of detecting lymphocyte activation of Group XVI is not required by the claims of Groups VI-XV and Groups XVII-XVIII. The method step of detecting antibody binding of Group XVII is not required by the claims of Groups VI-XVI and Group XVIII. The method step of detecting mitogenic activity of Group XVIII is not required by the claims of Groups VI-XVII.

7. Because these inventions are distinct for the reasons given above and the structure and literature searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. For example, a patentability determination for Group I would involve a determination of the patentability of a device that is a positionally addressable array while a patentability determination for Group VII would involve a consideration of the patentability of a method for making an array by casting a mold. These considerations are very different in nature.

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8. A telephone call was made to Adriane M. Antler on 3/26/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999.

The examiner can normally be reached on M-F 8:00-4:30.

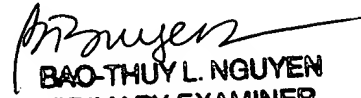
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-872-9307 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

mct

March 28, 2002

  
BAO-THUY L. NGUYEN  
PRIMARY EXAMINER  
4/1/02